

Attorney's Docket No.: 12671-016001  
Client's Ref. No.: 1007US

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Applicant : Stevan Horning et al.  
Serial No. : 10/763,401  
Filed : January 23, 2004

Art Unit : 2881  
Examiner : Zia R. Hashmi

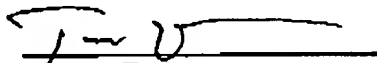
Title : Controlling Ion Populations in a Mass Analyzer

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is RESPONSE TO OFFICE ACTION OF APRIL 19, 2005, faxed this 19<sup>th</sup> day of May, 2005, to the United States Patent and Trademark Office.

Respectfully submitted,

Date: May 19, 2005

  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No. : 10/763,401  
Filed : January 23, 2004  
Title : CONTROLLING ION POPULATIONS IN A MASS ANALYZER

Art Unit : 2881  
Examiner : Zia R. Hashmi

MAY 19 2005

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION OF APRIL 19, 2005

The applicant thanks the Examiner for clarifying by phone that Group I as noted in the office action dated April 19, 2005 includes claims 1-52 and 76-79 rather than 1, 52, and 76-69. Responsive to that office action, applicant elects claims 1-52 and 76-79 of Group I should the requirement for restriction be maintained, and provisionally elects species 2 disclosed in Fig. 3 and at least claims 1-29, 31-34, 35-37, 38-52, and 76-79, should the requirement for restriction be maintained and no generic claim be finally held allowable.

The requirement for restriction is respectfully traversed.

The applicant respectfully notes that the Examiner has incorrectly characterized the method claims of Group I and the computer program product claims of Group II as combination and subcombination, as described in M.P.E.P. § 806.05(c)(I). However, these groups are properly related as a process and an apparatus for its practice, as described in M.P.E.P. § 806.05(e). That is, the method claims are directed to a process while the computer program product claims are directed to an apparatus for the practice of the process.

## CERTIFICATE OF TRANSMISSION BY FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

May 19, 2005

Date of Transmission

Signature

Lani M. Cummings

Typed or Printed Name of Person Signing Certificate

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As explained at M.P.E.P. § 806.05(e), process and apparatus are shown to be distinct when "the apparatus *as claimed* can be used to practice another and materially different process." The Examiner, in support of the restriction, had noted that computer program products "tangibly embody instructions operable to cause apparatus to perform any desired functions." But instructions to perform any desired function are not being claimed here. In fact, the elements of independent method claims 1, 30, 31, and 35 correspond to the elements of independent computer program product claims 53, 70, 71, and 75. Thus, the apparatus *as claimed* is used to practice the exact steps of the corresponding process claims, and cannot be used to practice another and materially different process, as would be required to support restriction.

Even if the relationship between the claims is one of combination-subcombination, the Examiner has not shown two-way distinctness between the "combination" computer program claims and the "subcombination" method claims. As explained in M.P.E.P. § 806.05(c)(I), combination and subcombination are distinct when a combination does not set forth the details of the subcombination as separately claimed. But as noted above, all of the steps of the method claims are described by the computer program products as claimed. If the steps of the methods are denoted as  $B_{sp}$ , the computer program products can include instructions, A, for implementing the methods. The Examiner, however, has provided no evidence, as explained in M.P.E.P. § 806.05(c)(II), that the computer program products ( $AB_{sp}$ ) are patentable without the details of the separately claimed methods ( $B_{sp}$ ).

The applicant's undersigned representative is available to confer at the Examiner's convenience regarding restrictions for this case. But for all of the above reasons, the applicant respectfully submits that restriction should not be required. It is therefore respectfully requested that the requirement for restriction be withdrawn.

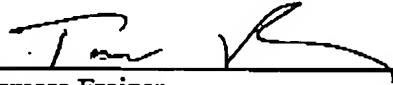
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 06 1050.

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